



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,729	03/28/2002	Preeti Lal	PF-0687 USN	8120

7590

10/01/2003

Incyte Genomics
Legal Department
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER

RAO, MANJUNATH N

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 10/01/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,729

Applicant(s)

LAL ET AL.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-16, 20 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-6, 8-16, 20, 23-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1652

DETAILED ACTION

Claims 1-6, 8-16, 20, 23-26 are currently pending in this application. Examiner acknowledges the election with traverse of group I in response to the previous Office action. However, Examiner has now discovered that polypeptides with SEQ ID NO:1-5 and polynucleotides with SEQ ID NO: 6-10 encoding the above polypeptides are distinct from each other both structurally and functionally and therefore has restricted them further as follows.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 8, 10-11, 15, drawn to an isolated **CMP-N-acetylneuraminic acid synthetase** polypeptide with SEQ ID NO:1 encoded by a polynucleotide with SEQ ID NO:6, vectors, host cells comprising the same and a method of making the polypeptide.

Group II, claim(s) 1-6, 8, 10-11, 15, drawn to an isolated **α 2,6-sialyltransferase** polypeptide with SEQ ID NO:2 encoded by a polynucleotide with SEQ ID NO:7, vectors, host cells comprising the same and a method of making the polypeptide.

Group III, claim(s) 1-6, 8, 10-11, 15, drawn to an isolated **α 1,2-mannosidase** polypeptide with SEQ ID NO:3 encoded by a polynucleotide with SEQ ID NO:8, vectors, host cells comprising the same and a method of making the polypeptide.

Group IV, claim(s) 1-6, 8, 10-11, 15, drawn to an isolated **cytosolic β -glucosidase** polypeptide with SEQ ID NO:4 encoded by a polynucleotide with SEQ ID NO:9, vectors, host cells comprising the same and a method of making the polypeptide.

Art Unit: 1652

Group V, claim(s) 1-6, 8, 10-11, 15, drawn to an isolated **UDP-glucuronosyl transferase** polypeptide with SEQ ID NO:5 encoded by a polynucleotide with SEQ ID NO:10, vectors, host cells comprising the same and a method of making the polypeptide.

Group VI, claim 9, drawn to an antibody which specifically binds to one of the elected polypeptide.

Group VII, claim 12-14 drawn to a method of detecting a specific target polynucleotide.

Group VIII, claim 16, drawn to a method of treating a disease using a pharmaceutical composition.

Group IX, claim 20, drawn to a method of screening for a compound for effectiveness as an antagonist of a polypeptide.

Group X, claim 23, drawn to a method of screening for a compound for effectiveness in altering the expression of a target polynucleotide.

Group XI, claim 24, drawn to a method of screening for a compound that specifically binds to a polypeptide.

Group XII, claim 25, drawn to a microarray of polynucleotides.

Group XIII, claim 26, drawn to a method of generating an expression profile of a sample which contains polynucleotide.

The inventions listed as Groups I-XIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

1. The first recited product of the above invention, i.e., polypeptide with SEQ ID NO:1 or a amino acid sequence having at least 90% sequence identity to SEQ ID NO:1 with a CMP-N-acetylneuraminic acid synthetase activity is already known in the art (see Munster et al. (PNAS, USA, Vol. 95 :9140-9145). Therefore when the invention is considered as a whole does not contribute over the prior art.

2. Pursuant to 37 C.F.R. 1.475 (d), the ISA/US considers that where multiple products and processes are claimed, the main invention shall consist of the first invention of the category first mentioned in the claims and the first recited invention of each of the other categories related

thereto. Accordingly, the main invention (Group I) comprises the first-recited product i.e., polypeptide with SEQ ID NO:1 having CMP-N-acetylneuraminic acid synthetase activity, a polynucleotide with SEQ ID NO:6 encoding the above polypeptide, a vector, a host cell, a method for producing CMP-N-acetylneuraminic acid synthetase polypeptide. Further pursuant to 37 C.F.R. 1.475 (d), the ISA/US considers that any feature which the subsequently recited products and methods share with the main invention does not constitute a special technical feature within the meaning of PCT Rule 13.2 and that each of such products and methods accordingly defines a separate invention.

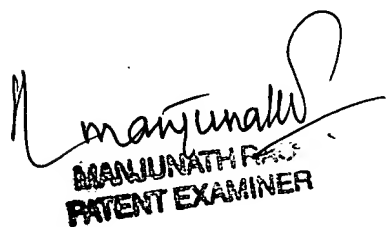
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura

Art Unit: 1652

Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

A handwritten signature in cursive script, appearing to read 'Manjunath', is written over a rectangular stamp. The stamp contains the text 'MANJUNATH N. RAO' on the top line and 'PATENT EXAMINER' on the bottom line, both in a bold, sans-serif font.

Manjunath N. Rao
September 26, 2003